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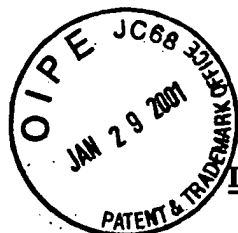
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****PATENT  
2762-US1  
RECEIVED**TECH CENTER 1600/2900  
2001  
1652

Applicant(s): STEINER, Mitchell S., et al Examiner:

Serial No.: 09/449,817

Group Art Unit:

Filed: November 26, 1999

Title: AN ISOLATED NUCLEIC ACID ENCODING P-HYDE PROTEIN AND  
METHODS OF INDUCING SUSCEPTIBILITY TO INDUCTION OF  
CELL DEATH IN CANCERASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, DC 20231

ATTN: LICENSING AND REVIEW

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APR 11 2001

**COMMUNICATION IN RESPONSE TO  
REQUEST FOR PROPERTY RIGHTS STATEMENT**

TECH CENTER 1600/2900

Sir:

Applicants attach hereto a copy of a Petition filed in response to the Request for Property Rights Statement dated December 13, 2000 issued by the United States Patent and Trademark Office in connection with the above-identified Application. A copy of the Request (Form PTO-456) is attached hereto as Appendix 2.

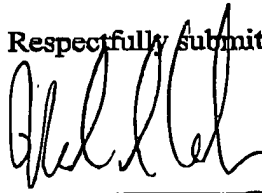
A response to the Request is due forty five (45) from the mailing date of the Request, namely January 28, 2001. Since January 28, 2001 falls out on a Sunday, a response is due the next business day, i.e. Monday January 29, 2001. Accordingly, this Communication is being timely filed.

In the Petition, Applicants request that the Assistant Commissioner for Patents withdraw the Request For Property Rights because the Request was issued in error and is improper. In the Request, the Examiner incorrectly asserted that the subject Application "appears to be useful in the production or utilization of special nuclear material or atomic energy as recited in 42 U.S.C. 2182 DOE". However, under 37 C.F.R. 1.4, "[a]pplications for patents which disclose or which appear to disclose, or which purport to disclose, inventions, or discoveries, relating to atomic energy are reported to the Department of

Energy...". Thus, for the Request to be proper the application must disclose or appear to disclose, or purport to disclose, inventions, or discoveries, relating to atomic energy. Rather, the subject Application is directed to biological material, namely nucleic acids and proteins of P-Hyde and methods of inducing cellular death using the protein. The nucleic acids and proteins of P-Hyde and the methods of use do not relate to atomic energy. Therefore, the Request is incorrect and improper. Accordingly, Applicants request that the Request be withdrawn.

No fees are believed to be necessitated by the instant Communication. However, if any fee is due, the Patent Office is hereby authorized to charge Deposit Account No. 05-0649.

Respectfully submitted,



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Mark S. Cohen  
Attorney for Applicant(s)  
Registration No. 42,425

Date: January 29, 2001

Eitan, Pearl, Latzer & Cohen-Zedek  
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Telephone: (703) 486-1177  
Fax: (703) 486-0800

**PATENT**  
**P-2762-US1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): STEINER, Mitchell S., et al      Examiner: Keer, K  
Serial No.: 09/449,817      Group Art Unit: 1652  
Filed: November 26, 1999

Title: AN ISOLATED NUCELIC ACID ENCODING P-HYDE PROTEIN AND  
METHODS OF INDUCING SUSCEPTIBILITY TO INDUCTION OF  
CELL DEATH IN CANCER

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, DC 20231

ATTN: Box DAC

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FEB 1 2001  
TECH CENTER 1600/2900

**PETITION TO WITHDRAW**  
**REQUEST FOR PROPERTY RIGHTS STATEMENT**

Sir:

Applicants' petition the Assistant Commissioner For Patents to withdraw the Request For Property Rights (PTO Form-456) dated December 13, 2000 issued by the United States Patent and Trademark Office in connection with the above-identified Application.

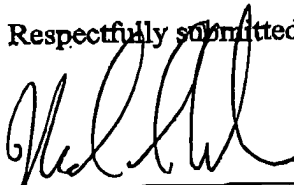
The Request was issued in error and is improper. In the Request, the Examiner incorrectly asserted that the subject Application "appears to be useful in the production or utilization of special nuclear material or atomic energy as recited in 42 U.S.C. 2182 DOE".

Under 37 C.F.R. 1.4, "[a]pplications for patents which disclose or which appear to disclose, or which purport to disclose, inventions, or discoveries, relating to atomic energy are reported to the Department of Energy...". Thus, for the Request to be proper the application must disclose or appear to disclose, or purport to disclose, inventions, or discoveries, relating to atomic energy. Rather, the subject Application is directed to biological material, namely nucleic acids and proteins of P-Hyde and methods of inducing cellular death using the protein. The nucleic acids and proteins of P-Hyde and the methods of use do not relate to

atomic energy. Therefore, the Request is incorrect and improper. Accordingly, Applicants request that the Request be withdrawn.

A fee of One Hundred and Thirty Dollars (\$130.00) under 37 C.F.R. 1.17(h) is due for this Petition. If any additional fees are due, the Patent Office is hereby authorized to charge Deposit Account No. 05-0649 for such fees or deficiencies.

Respectfully submitted,



Mark S. Cohen  
Attorney for Applicant(s)  
Registration No. 42,425

Date: January 29, 2001

Eitan, Pearl, Latzer & Cohen-Zedek  
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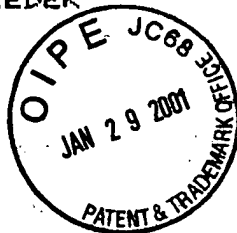

**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/449,817	11/26/99	STEINER	M P-2762-US1

 EITAN PEARL LATZER & COHEN-ZEDEK  
LONDON & STARK ASSOCIATES  
2011 CRYSTAL DRIVE  
ONE CRYSTAL PARK SUITE 210  
ARLINGTON VA 22202-3709

PM51/1213



EXAMINER	
KERR, K	
ART UNIT	PAPER NUMBER
1652	

DATE MAILED:

12/13/00

**RECEIVED**  
2001

**IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A  
FORMAL REQUIREMENT WILL BE ISSUED**

The subject matter of this application appears to:

☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).

☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example must appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 306-4191.

**PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE  
ATTENTION OF LICENSING AND REVIEW**

 U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office